

REMARKS

In the Office Action, the Examiner rejected Claims 1-45, which are all of the pending claims, over the prior art, principally U.S. Patent 6,073,138 (de l'Etraz, et al.). Specifically, Claims 1-5, 10-20, 25-35 and 40-45 were rejected under 35 U.S.C. 102 as being fully anticipated by de l'Etraz, et al; and Claims 6-9, 21-24 and 36-39 were rejected under 35 U.S.C. 103 as being unpatentable over de l'Etraz in view of U.S. Patent 6,014,634 (Scroggie, et al.).

The Examiner also rejected Claims 1, 16 and 31 under 35 U.S.C. 101 as directed to non-statutory subject matter; and rejected Claims 1, 4-6, 10, 11, 14, 16, 19, 20, 25, 26, 29, 31, 34-36, 40, 41 and 44 under 35 U.S.C. 112 as being indefinite. In addition, the Examiner objected to the language of Claims 1, 16, 31, 35, 36 and 45, and in particular, the Examiner objected to the use of the word "for" in the body of these claims.

After careful consideration of the present application, the claims, the prior art, and the Examiner's comments, Applicants respectfully traverse all of the above-identified rejections and objections. For the reasons discussed below, the Examiner is asked to reconsider and to withdraw these rejections and objections and to allow Claims 1-45.

With respect to the rejection of Claims 1, 16 and 31 under 35 U.S.C. 101, the Examiner argued that these claims do not list any hardware, that Claim 31 needs a processor, and that Claim 16 recites a system while the specification does not list the system to include hardware. Applicants respectfully submit that none of these reasons is a sufficient reason for rejecting any of Claims 1, 16 or 31 as being non-statutory. Moreover, all of Claims 1, 16 and 31 are, in fact, directed to statutory subject matter.

It is noted that Claims 16 and 31 clearly do recited structure. Claim 16 includes, among other elements, a separator, a logical link creator and a receiver, and Claim 31 includes a computer readable medium.

Claim 1 is a method claim directed to accessing data records in a private data set, and the claim positively sets forth the steps needed to perform this accessing in accordance with the present invention. 35 U.S.C. 101 expressly states that a patent may be obtained for, among other types of inventions, a new and useful process. The method of Claim 1 clearly describes a process within the meaning of 35 U.S.C. 101, and this is of the type allowed by 35 U.S.C. 101. In addition, there is no requirement in 35 U.S.C. 101 that a method claim include structure or hardware. In deed, one purpose of method claims is to define the invention in a manner that minimizes the requirement for specific structure.

Claim 16 is a system claim directed to accessing data records in a private data set. Claim 16 is statutory because it is a system claim, which is permissible under 35 U.S.C. 101, and, in addition, the claim is consistent with the specification. Claim 16 sets forth structure, and, specifically, describes structure for achieving that access to data records in a private data set. Moreover, the present specification expressly states that the present invention may be embodied in a system. For instance, on page 1, paragraph 2; the specification expressly indicates that the present invention relates to “a method, system and program product for allowing the viewer of a public data set to access related records in a private data set. Paragraph 6 of the specification also expressly indicates that the present invention may be embodied in a system.

Claim 31 is directed to a computer program product comprising a computer readable medium having computer readable program code thereon. Claim 31 is thus directed to an article of manufacture within the meaning of 35 U.S.C. 101, and is thus statutory. This article of

manufacture does not include a processor, and 35 U.S.C. 101 does not require that the claim to this article of manufacture include a processor.

For the reasons discussed above, Claims 1, 16 and 31 define statutory subject matter within the meaning of 35 U.S.C. 101, and the Examiner is asked to reconsider and to withdraw the rejection of these claims under 35 U.S.C. 101.

In rejecting Claims 1, 4-6, 10, 11, 14, 16, 19, 20, 25, 26, 29, 31, 34-36, 40, 41 and 44 under 35 U.S.C. 112, second paragraph, as being indefinite, the Examiner objected to two phrases in these claims. In particular, the Examiner objected to “predefined operation” and to “required condition.” The Examiner argued that it is not clear what the “predefined operation” or the “required condition” are.

These terms, however, are clear and definite and would be well understood by those of ordinary skill in the art. Claim 1, for example, refers to a request to perform “a predefined operation.” This operation may be any suitable or appropriate operation that is used in the invention, and that is defined before the request is received. Those of ordinary skill in the art would be readily able to practice the invention of Claim 1 and to determine whether a particular method does or does not come within the scope of Claim 1.

Also, Claim 10, for example, indicates that “the predefined operation step is performed only when a required condition is satisfied.” This condition may be any suitable or appropriate condition that must be satisfied in order for the predefined operation to be performed. Here too, those of ordinary skill in the art would be able both to practice the subject matter of the claim and to determine whether another method does or does not come within the scope of Claim 10.

In addition, the specification provides examples of operations and conditions that may be used as the predefined operation or the required condition. For instance, with the example of the invention discussed on pages 8-12 of the specification, the predefined operation may be to read data in the private data set, and the required condition may be that the consumer permits a particular merchant to have that read access.

In view of the foregoing, Claims 1, 4-6, 10, 11, 14, 16, 19, 20, 25, 26, 29, 31, 34-36, 40, 41 and 44 are clear and definite and fully comply with the requirements of 35 U.S.C. 112, second paragraph. Consequently, the Examiner is asked to reconsider and to withdraw the rejection of Claims 1, 4-6, 10, 11, 14, 16, 19, 20, 25, 26, 29, 31, 34-36, 40, 41 and 44 under 35 U.S.C. 112.

The Examiner, in the Office Action, also objected to the use of the word “for” in the bodies of Claims 1, 16, 31, 35, 36 and 45. The Examiner argued that the word indicates intended use and as such does not carry patentable weight. The Examiner argued that the limitations following the phrase “for” describes only intended use but not necessarily required functionality of the claim.

Applicants respectfully note that the body of Claim 1 does not use the word “for.” Accordingly, it is believed that the above rejection of Claim 1 should be withdrawn

Claims 16, 31, 35, 36 and 45 do have the word “for” in the bodies of the claims. This use is proper, though, and the functional limitations following the word “for” should be taken into account when determining the patentability of the claims. In particular, these functional limitations are not mere intended results.

Applicants have considerable discretion in defining their inventions. In the present case, the functional language following the word “for” is a positive limitation and indicates how a particular element operates in use.

For example, Claim 16 describes “computer readable program code for separating a data record into a public data record stored in a public data set and a private data record stored in a private data set. The functional language after the word “for” does not describe merely a desired result, but instead describes the required operation of this computer readable program code. Similarly, the functional language in Claims 31, 35, 36 and 45 describe the required operations of various elements, and these elements, when operated, must be operated in these ways in order for a particular computer program product to come within the scope of these claims.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the above-discussed objection to Claims 1, 16, 31, 35, 36 and 45, and that the functional language used in these claims be considered when determining the patentability of the claims.

With respect to the issue of patentability, Applicants respectfully note that there are a number of important features of the invention that are not shown in or suggested by de l’Etraz, et al.

For example, de l’Etraz, et al. does not disclose a logical link logically relating the public data record stored in a public data set with the private data record stored in a private data set. In the Office Action, the Examiner cited column 10, lines 47-65 of de l’Etraz, et al. as disclosing this logical link. This portion of de l’Etraz, et al. discusses two databases, a private database 102 and a public database 102, and indicates that these databases share similar structure. There is no teaching, though, of creating a logical link between a particular data record in one of the databases and another particular data record of the other database.

Also, de l'Etraz, et al. does not disclose the feature of finding a private data record. The Examiner cited column 5, lines 55-63 of de l'Etraz, et al. as disclosing this feature. This portion of de l'Etraz, et al. discusses a data-mining tool that may be used to allow a manager to access employees' private contact data but disallow employees to access fellow employees' private contact data. There is no disclosure or suggestion in this portion of de l'Etraz, et al. of finding the private data record in the manner described above – that is, using the information from the public data record received from a user in combination with the above-mentioned logical link.

These other references of record have been reviewed, and these other references, whether considered individually or in combination, also do not disclose or suggest these features.

For instance, Scroggie, et al. was cited for using certain information a network address, and transmitting a message to that address. Scroggie, et al. does not disclose or suggest the above-discussed logical link or using that link to find the private data record.

Independent Claims 1, 16 and 31 describe important features of the present invention that are not shown in or suggested by the prior art. In particular, each of these claims describes the features of creating a logical link logically relating the public data record with the private data record, and finding the private data record-using information from the public data record received from a user in combination with this logical link.

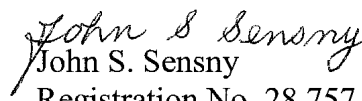
Because of the above-discussed differences between Claims 1, 16 and 31 and the prior art, and because of the advantage associated with those differences, it cannot be said that any of Claims 1, 15 or 31 is anticipated by or is obvious in view of the prior art. Accordingly, Claims 1, 16 and 31 patentably distinguish over the prior art and are allowable. Claims 2-15 are dependent from Claim 1 and are allowable therewith; and Claims 16-30 are dependent from, and are allowable with, Claim 15. Similarly, Claims 31-45 are dependent from Claim 30 and are allowable therewith. The Examiner is thus asked to reconsider and to withdraw the rejection of

Claims 1-5, 10-20, 25-35 and 40-45 under 35 U.S.C. 102 and the rejection of Claims 6-9, 21-24 and 36-39 under 35 U.S.C. 103, and to allow Claims 1-45.

For the reasons set forth above, the Examiner is respectfully requested to reconsider and to withdraw the rejection of Claims 1, 16 and 31 under 35 U.S.C. 101, the rejection of Claims 1, 4-6, 10, 11, 14, 16, 19, 20, 25, 26, 29, 31, 34-36, 40, 41 and 44 under 35 U.S.C. 112, and the objection to the language of Claims 1, 16, 31, 35, 36. The Examiner is also asked to reconsider and to withdraw the rejection of Claims 1-5, 10-20, 25-35 and 40-45 under 35 U.S.C. 102 and the rejection of Claims 6-9, 21-24 and 36-39 under 35 U.S.C. 103, and to allow Claims 1-45.

Every effort has been made to place this application in condition for allowance, a notice of which is requested. If the Examiner believes that a telephone conference with Applicants' Attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully submitted,


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